

Official

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were submitted that were not included on the IDS. These are an article by George Alexander (Custom Book Printing & Book Printing on Demand), a 1992 Report on Publishing Systems by Anita Maling, and an article by MacWeek on Speedy PostScript Printers Spur Publishing On Demand. A revised IDS is submitted that is believed to list all patents, publications, or other information already submitted in the Petition to Make Special, and submitted with the IDS. If the Examiner has a specific reference or references that is believed omitted, please identify them. Otherwise, the Examiner is requested to acknowledge receipt of the references submitted by Applicant in the IDS.

Because all of the cited references were previously submitted, no fee is believed due for this revised IDS.

ALLOWABLE CLAIMS

Dependent Claims 2, 5-6, 10, 12, 13 17, 21-23, 33, 36, 41, and 44 were indicated as allowable if rewritten. The Applicant accepts the allowance of these claims. But the independent claims are believed allowable as written, and thus the dependent claims are not being rewritten at this time.

OBVIOUSNESS

The Examiner rejected independent claims 1, 16, & 30 as obvious over Panec (5,957,693), and rejected the remaining independent Claim 39 as obvious over Panec combined with Huffman (5,661,635). A number of dependent claims were also rejected as obvious. The Applicants believe Panec does not disclose what it is cited for, and request reconsideration in view of the following comments.

Claim 1 is used for illustration. Basically, Panec marks text for a skilled reader with one indicia, and marks text for a novice reader with a second indicia. But the marking is based on the amount of text read, and alternates between the two readers. It is not based on the character in the story being read, and Panec shows the same indicia used with multiple characters. That is different from the claims under examination.

Independent Claim 1 defines text for the dialogue of first and second characters and a narrator, with the text presented in a first indicia for the first character throughout substantially all the presentation. It requires second indicia for the dialogue of the second character

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throughout substantially all the presentation. Independent Claims 16 and 30 have claim requirements raising similar bases of distinction. Claim 1 states:

"1. A presentation of textual material having text corresponding to the dialogue a plurality of characters and narrative, wherein the text for the dialogue of a first character is presented in a first indicia throughout substantially all the presentation, and wherein the text for the dialogue of a second character is presented in a second indicia throughout substantially all the presentation, the first and second indicia being different."

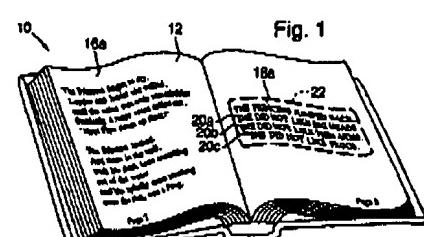
Independent Claims 16 and 30 define features raising similar bases for distinguishing Panec. Independent Claim 16 defines presenting text corresponding to a first and second character, in first and second indicia, for at least a substantial portion of the text corresponding to those characters. Independent Claim 30 defines presenting dialogue for each of a plurality of characters in a unique indicia for each character throughout a substantial portion of the dialogue.

Panec Marks Text According To The Reader's Ability, Not By Character Dialogue

The Examiner says that Panec has dialogue for a character in a first indicia throughout the presentation: "Panec discloses text for the dialogue of a character presented in a first indicia throughout the presentation (FIG 1; col. 5, ll. 15 et seq) . . ." Office Action at 2. That is incorrect. The cited portions show text for different readers presented in different letter size (indicia). The text does not differ based on the character being read. Because the text is not marked according to the character in the story being read, Panec cannot even meet the claimed requirement that "the dialogue of a first character is presented in a first indicia throughout substantially all the presentation " as defined in Claim 1 and other independent claims. It also cannot meet the requirement of "the dialogue of a second character is presented in a second indicia throughout substantially all the presentation."

Specifically, the citation to Col. 5, lines 15 et seq. in Panec states that the text is written for the level of the reader's skill, it does not say it is associated with the dialogue of a character: "FIGS 1 and 2 show that the book further comprises indicia distinguishing the skilled reader's text from the novice reader's."

This is shown by cited FIG. 1 of Panec which shows 11 lines of text containing narration in small print size. While FIG. 1



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shows the next page having a different indicia (larger text size) it also contains text for the narrator, and contains no text for any character. In Fig. 1 there is thus no teaching of using different text size for the dialogue of different characters, and no teaching of using a specific text size for a single character for a substantial portion of the presentation as defined in Claim 1.

Most of the remaining figures show the story of the Emperor's new clothes, but the same indicia (letter size) is used for dialogue of the Emperor (Fig. 18), the servants (Fig. 20), four men (Fig. 30), townspeople (Fig. 34, 40), and the child who sees no clothes (Fig. 36, 38). That teaches against using the same letter size for the dialogue of a single character.

Indeed, Panec states that the text should alternate between readers regardless of the character involved in the portion being read. The alternation is such that "each novice reader's section has roughly half as many words as the preceding skilled reader's section." This "alternating pattern preferably begins at the beginning of the story and continues through to the end." Col. 3, lines 38-43.

Panec thus does not disclose text for the dialogue of a character presented in a first indicia throughout the presentation as maintained in the prior Office Action. Panec does not even use the term "dialogue" in his patent, and the word "character" appears only once, where Panec says the novice reader may introduce new characters in order to maintain the interest of the novice reader. Col. 2, lines 23-24.

For the above reasons, there is no basis in Panec for presenting the dialogue in a first indicia for the first character throughout substantially all the presentation, and for presenting a second indicia for a second character throughout substantially all the presentation, as defined in Claim 1. Panec does not teach or suggest presenting text corresponding to a first and second character, in respective first and second indicia, for at least a substantial portion of the text corresponding to those characters, as defined in Independent Claim 16. Panec does not teach or suggest presenting dialogue for each of a plurality of characters in a unique indicia for each character throughout a substantial portion of the dialogue for each character.

For the above reasons, Panec does not disclose the basic requirements of independent Claims 1, 16 and 30.

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As Panec Does Not Mark Text According To Character Dialogue, It Is Not Obvious To Modify Panec To Mark Text By Character Dialogue

The Examiner correctly concluded that "Panec fails to disclose text indicia differing for different characters." The Examiner says that providing differing indicia for the dialogue of different characters would be obvious because Panec "discloses alternating readers for the multiple characters throughout the story," citing Panec, Col. 3, lines 38 et seq. and FIGS 2-4. Office Action at 2.

The cited text merely says that the text alternates between a skilled reader and a novice reader:

"As seen in FIGS. 1 and 2, sections 16a, b and 18a, b are arranged in alternating sequence, first the skilled reader's section 16a and then the novice reader's section 18a, then the skilled readers section 16b, then the novice reader's section 18b. This alternating pattern preferably begins at the beginning of the story and continues through to the end." Col. 3, lines 38-43.

Consistent with this teaching, Figures 1-2 show one text size containing both the narrator and character text, and show a second text size that contains narrator text. Only a portion of the story is shown, but the text size alternates between skilled reader and novice reader, and does not distinguish between the text associated with any of the characters. Indeed, as stated by Panec itself, the text merely alternates, page by page, regardless of the character involved in the story.

The literal teaching of Panec is thus that the reading levels alternate between a skilled reader and a novice reader, regardless of which character's dialogue is being read. This conclusion is reinforced when Panec says that the text of the novice reader can introduce new characters. Col. 2, lines 21-23. If the text for the novice reader is always larger, then multiple characters will be associated with the same, larger text. Thus, one indicia is associated with multiple characters. (Claim 30 defines unique indicia). Further, when the skilled reader reads dialogue involving the same character, there will be two different indicia associated with the character dialogue whereas Claim 1 says that the first or second indicia be used "substantially throughout the presentation" and Claim 16 has a similar requirement. Panec thus teaches against a single indicia for a character's dialogue throughout substantially all the presentation for first and second characters. The teaching in Panec that the text alternate between the two reading

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levels prevents the association of the first and second indicia with first and second characters as defined in Claim 1 and the independent Claims 16 & 30.

Panec Does Not Establish A Prima Facie Case Of Obviousness

To establish even a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in prior art references or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991), M.P.E.P. § 2143.

The third criteria is missing here, as the Examiner has shown no reference, which when combined with Panec or properly modified, achieves the claimed combination. Indeed, Panec teaches against the claimed combination because it alternates text between two reading levels, based on length of text being read. Col. 3, lines 38-49. This missing requirement for establishing a *prima facie* case of obviousness warrants withdrawing the rejection.

There Is No Basis In The Record For A Suggestion To Modify Panec

The Examiner must not only explain the motivation for modifying or combining references, but must point to some concrete evidence in the record supporting the motivation to modify or combine.

"As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise." In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (emphasis added).

Here, the Examiner cites to the part of Panec that says you alternate text between skilled and novice readers and do so based on the length of the text. But that provides no motivation to change the marking of the text so that only the dialogue of a first character is marked with a first

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indicia throughout substantially all the presentation. There is nothing cited to explain why Panec would be modified to alternate indicia between characters rather than alternate according to reading skill or the amount of text read, as Panec actually teaches. There is no basis in the record suggesting a modification that would achieve the claimed combinations. Indeed, Panec does not even use the word "dialogue" in its patent and only uses the word "character" once and then in an inapplicable context. *See Col. 2, lines 23-24.*

To modify a reference there must be some suggestion to do so, even for simple changes like turning a device upside down. *See In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) ("Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down." (citation omitted)).

As there is no motivation to modify the Panec reference found in the record, the Examiner is respectfully requested to reconsider, and withdraw the obviousness rejections on the independent Claims 1, 16 and 30.

INDEPENDENT CLAIM 39 IS NOT OBVIOUS

The Examiner rejected Independent "means" Claim 39 based on Panec and Huffman. Office Action at 5-6. The Examiner is requested to reconsider, and withdraw that rejection in view of the following comments.

Claim 39 defines "means" for selecting text for a first and second character that is appropriate for the reading level of a reader assigned to that character:

means for selecting text for a first character appropriate for the reading level of a first reader assigned to the first character;

means for selecting text for a second character appropriate for the reading level of a second reader assigned to the second character;

Claim 30 also defines "means" for presenting the above selected text for a substantial portion of the dialogue for the first or second character.

As discussed above, Panec does not assign any particular character to the indicia of the novice reader or the skilled reader. Panec alternates between reading levels, irrespective of what character dialogue is being read. Panec cannot disclose or suggest these two claim elements which select text for a first and second character, and cannot disclose or suggest the presenting means for a substantial portion of the dialogue of those first and second characters.

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Huffman does not cure these deficiencies. The Examiner cites two portions of Huffman. The first portion, Col. 5, lines 22 et seq mentions receiving, storing and displaying information. It says nothing about associating character dialogue with a particular reader. The second portion, col. 13, lines 55-67 says a user can select and highlight the selected text. It also says nothing about selecting a substantial portion of the text associated with a single character and associating it with a particular reader.

Even if combined, the Panec and Huffman references do not result in the claimed combination.

As discussed above, there is no suggestion to modify Panec, Huffman or Panec combined with Huffman, in order to achieve the claimed combination.

The Examiner is thus requested to reconsider and withdraw the rejection of Claim 39. In the alternative, the Examiner is requested to identify the motivation to combine and modify, and the basis in the record for those modifications and combinations.

THE DEPENDENT CLAIMS ARE NOT OBVIOUS

Dependent Claims 3-4, 7, 9, 11, 15, 18, 19-20, 24, 28-29, 31-32, 34-35 and 38 were rejected as obvious based on Panec. Dependent Claims 8, 14, 25-27, 37, 40 and 42-43 were rejected as obvious over Panec in view of Huffman.

As discussed above, Panec does not disclose the basic requirements of the independent Claims 1, 16, 30 and 39. Thus, even if combined with Huffman the claimed combinations are not achieved.

There is also no motivation to modify or to combine. The lack of a motivation to modify Panec is discussed above. The Examiner says it is obvious to combine Panec and Huffman because "Huffman discloses inputting book data in to a processor and providing an interface to manipulate and control the display of the book data (FIGS. 2 & 3)." Office Action at 6. But just because manipulation and control over a display can be done, that does not suggest the combinations defined in the claims. Even if data can be input, manipulated and displayed, something has to suggest inputting, manipulating and displaying the claimed combination. That is not done here.

Further, Figs. 2-3 of Huffman do nothing but show a schematic in which devices are connected to a processor. There is nothing to suggest any modification as defined in the claims.